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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,641	11/28/2001	Nobuya Matsuoka	215869US0PCT	5497
22850	7590	11/18/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COVINGTON, RAYMOND K	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,641

Applicant(s)

MATSUOKA ET AL.

Examiner

Raymond Covington

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,13,14,31,32,34,36,38 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,13,31,32,34,36,38 and 56 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/28/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 13, 31, 32, 34, 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The nature of the invention: The nature of the invention is a method for prophylaxis or treatment of one or more cerebral diseases, e.g., dementia or amnesia, claims 13 using a compound of claim 8 or 56 for expressing long-term potentiation of synaptic transmission, said compounds being determined by in vitro screening, claims 31, 32 and 34.

The state of the prior art: The state of the prior art is that it involves screening in vitro to determine which compounds exhibit expressing

long-term potentiation of synaptic transmission (i.e. what compounds can treat which specific disease). There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The predictability in the art: It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In *re Fisher*, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. In the instant case, the instantly claimed invention is highly unpredictable since one skilled in the art would recognize that in regards to the therapeutic effects of all diseases, whether or not the compounds of claims 8 and 56 would make a difference in the disease. It is not seen where the instant specification adequately describes the nexus between expressing long-term potentiation of synaptic transmission and a useful treatment of a single disease or condition. The specification does not adequately describe what is meant by expressing and potentiation. As to the screening method, this method is drawn to an in vitro selection of

compounds and does not adequately support or describe screening selection for treatment of a condition. For example, a screening method for an anti-dementia or amnesia condition is an in vivo. There is no nexus between selection of a compound and the treatment of a specific disease condition.

The presence or absence of working examples: There are insufficient exemplifications to support the prevention or treatment of all known cerebral diseases and conditions.

The amount of direction or guidance present: The specification does not seem to enable a correlation between expressing long-term potentiation of synaptic transmission and the prevention or treatment of all cerebral diseases and conditions.

The breadth of the claims: The claims are drawn to the prophylaxis prevention or treatment of any and all cerebral diseases and conditions using compounds of claim 8. There are many different types of nervous system diseases not regarded as preventable by those skilled in the art, because there simply is no known cure. In light of the aforementioned context, use of the term "prophylaxis" in the claimed invention equates to the use of the term "prevention" but provides no examples of how the prevention of such diseases are effectuated.

The quantity of experimentation needed: The quantity of experimentation needed is undue. One skilled in the art would need to determine what cerebral diseases or conditions out of all known diseases would be benefited by using the compounds of claim 8 and then would further need to determine which of the claimed compounds would provide treatment of the disease. The obstacles to non in vivo therapeutic approaches are well documented in the literature. See, for example, Huff {J. Med. Chem. 34(8) 1991, p. 2305-2314} on page 2314. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any treatment or any therapeutic regimen on its face. In order to provide proof of utility either clinical in vivo or in vitro data correlative to in vivo applicability or a combination of these can be used. However, the data must be such as to convince one of ordinary skill in the art that the proposed utility is sufficiently established as set forth in full, clear and exact terms in the disclosure. When the utility is directed to humans, the data must generally be clinical, however, adequate animal data would be acceptable in those instances wherein one of ordinary skill in the art would accept correlation to human utility. Thus, in order to rely on animal data, there must exist an art recognized animal

model for testing purposes. In re Hartop, 311 F.2d 249, 135 USPQ 419 (CCPA 1962).

The level of the skill in the art: The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity. As a result necessitating one of ordinary skill to perform an exhaustive search for which diseases can be treated by which compounds of claim 8 in order to practice the claimed invention.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

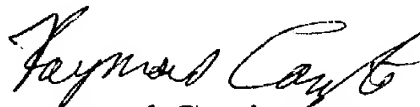
Therefore, in view of the Wands factors and In re Fisher (CCPA 1970) discussed above, to practice the claimed invention herein, one of ordinary skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compounds of the instant claims, with no assurance of success.

Claim 14 is objected to as depending from a rejected base claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (571) 272-0681. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Raymond Covington
Examiner
Art Unit 1625

RKC